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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. | |
|--------------------------------------|----------------|----------------------|---------------------|------------------|--|
| 10/762,515 | 01/23/2004 | Jacob Mozel | 4707-001 | 5240 | |
| 22429 7 | 590 02/28/2006 | | EXAM | INER | |
| LOWE HAUPTMAN GILMAN AND BERNER, LLP | | | FEELY, MICHAEL J | | |
| 1700 DIAGON | IAL ROAD | | | | |
| SUITE 300 /31 | 0 | | ART UNIT | PAPER NUMBÉR | |
| ALEXANDRIA | A, VA 22314 | | 1712 | | |

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | | Application No. | Applicant(s) | <u> </u> |
|--|---|---|--|----------|
| | | 10/762,515 | MOZEL ET AL. | |
| | | Examiner | Art Unit | |
| | | Michael J. Feely | 1712 | |
| π Period for R | he MAILING DATE of this communication app Reply | ears on the cover sheet with the | correspondence address | |
| WHICHE - Extension after SIX (- If NO peri Failure to Any reply | TENED STATUTORY PERIOD FOR REPLY EVER IS LONGER, FROM THE MAILING DAIS of time may be available under the provisions of 37 CFR 1.13 (6) MONTHS from the mailing date of this communication. od for reply is specified above, the maximum statutory period we reply within the set or extended period for reply will, by statute, received by the Office later than three months after the mailing atent term adjustment. See 37 CFR 1.704(b). | ATE OF THIS COMMUNICATION B(a). In no event, however, may a reply be to the rill apply and will expire SIX (6) MONTHS from the cause the application to become ABANDON | DN. imely filed m the mailing date of this communication. IED (35 U.S.C. § 133). | |
| Status | | | | |
| 1)⊠ Re | sponsive to communication(s) filed on 23 Ja | nuary 2004. | | : |
| · | <i>,</i> — | action is non-final. | | : |
| | nce this application is in condition for allowan | - | | Ģ |
| ClO | sed in accordance with the practice under E. | x parte Quayle, 1935 C.D. 11, 4 | 153 O.G. 213. | |
| Disposition | of Claims | | | |
| 4a) 5)□ Cla 6)□ Cla 7)□ Cla | aim(s) <u>1-32</u> is/are pending in the application. Of the above claim(s) is/are withdraw aim(s) is/are allowed. aim(s) is/are rejected. aim(s) is/are objected to. aim(s) <u>1-32</u> are subject to restriction and/or e | vn from consideration. | | |
| Application | Papers | | | |
| 10)∭ The App Rep | e specification is objected to by the Examiner of drawing(s) filed on is/are: a) acception acception and request that any objection to the oplacement drawing sheet(s) including the correction of the coath or declaration is objected to by the Examiner. | epted or b) objected to by the drawing(s) be held in abeyance. So on is required if the drawing(s) is o | ee 37 CFR 1.85(a). bjected to. See 37 CFR 1.121(d). | : |
| Priority unde | er 35 U.S.C. § 119 | | | |
| a) <u></u> | ,— , <u>—</u> | s have been received. s have been received in Applica ity documents have been receiv (PCT Rule 17.2(a)). | tion No ved in this National Stage | |
| Attachment(s) | | | | |
| | References Cited (PTO-892) | 4) Interview Summar | | |
| 3) 🔲 Informatio | Draftsperson's Patent Drawing Review (PTO-948) on Disclosure Statement(s) (PTO-1449 or PTO/SB/08) (s)/Mail Date | Paper No(s)/Mail D 5) Notice of Informal 6) Other: | ⊅ate Patent Application (PTO-152) | |

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DETAILED ACTION

Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, drawn to a liquid thermosetting ink, classified in class 106, subclass31.65.
 - II. Claims 23-31, drawn to a method for producing a liquid thermosetting ink, classified in class 523, subclass 440.
 - III. Claim 32, drawn to a method for producing a liquid thermosetting ink, classified in class 524, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case (2) the product as claimed can be made by another and materially different process, such as one that pulverizes and classifies the solid curing agent to achieve a maximal particle size of less than 2 microns.
- 3. Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be

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made by another and materially different process (MPEP § 806.05(f)). In the instant case (2) the product as claimed can be made by another and materially different process, such as one that pulverizes and classifies the solid curing agent to achieve a maximal particle size of less than 2 microns.

- 4. Inventions II and III are directed to related processes. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, process II involves precipitation of curing agent on filler, while process III coats curing agent on filler via homogeneous dispersion.
- 5. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
- 6. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.
- 7. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

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The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

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Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael J. Feely Primary Examiner Art Unit 1712

Willy

MICHAEL FEELY
PRIMARY EXAMINER

February 21, 2006